

# Chapter 600

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#### **601 Applicant May Be Represented by Attorney at Law**

The owner of a mark may file and prosecute his or her own application for registration of the mark, or he or she may be represented by a practitioner qualified under 37 C.F.R. §10.14 to practice before the United States Patent and Trademark Office (USPTO) in trademark cases. 37 C.F.R. §§2.11 and 10.14. *See* TMEP §602 regarding persons who may practice before the Office in trademark cases. If the applicant is represented by a practitioner qualified under 37 C.F.R. §10.14 to practice before the Office in trademark cases, the Office will communicate only with the practitioner, unless that representation is terminated without replacement. If the applicant contacts the Office regarding the application, the applicant will be advised that the Office will only discuss the matter with applicant's attorney. *See* TMEP §602.04 regarding revocation of a power of attorney.

#### **601.01 Office Cannot Aid in Selection of Attorney**

The Office cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of an application and needs more detailed or technical assistance than the examining attorney is permitted to give, the examining attorney may suggest to the applicant that it may be desirable to employ an attorney who is familiar with trademark matters. The following language may be used in the Office action:

The applicant may wish to hire a trademark attorney because of the technicalities involved in the application. The United States Patent and Trademark Office cannot aid in the selection of an attorney.

#### **602 Persons Who May Practice Before Office in Trademark Matters [R-2]**

*37 C.F.R. §10.14. Individuals who may practice before the Office in trademark and other non-patent cases.*

*(a) Attorneys. Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases.*

*(b) Non-lawyers. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to*

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*January 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.*

*(c) Foreigners. Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: The patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

*(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.*

*(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.*

### *United States Attorneys*

An attorney who is a member in good standing of the bar of any United States court or the highest court of any State may practice before the Office in trademark matters. No application for recognition to practice is necessary. The Office does not give an examination for eligibility or maintain a register of persons entitled to practice in trademark cases. An attorney at law who appears in person or signs a paper on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. 37 C.F.R. §§2.17(a) and (c).

Only individuals, not law firms, are entitled to be recognized to represent others. Generally, attorneys who have not specifically been mentioned in either a power of attorney or in correspondence filed with the Office may discuss but not conclude business with the Office over the telephone. However, if an attorney from the same firm as the attorney of record claims to be authorized by the attorney of record to conduct discussions with respect to a specific application, the examining attorney will permit the attorney to conclude business, and will note this fact in any resulting Office action.

### *Foreign Attorneys*

Under 37 C.F.R. §10.14(c), a foreign attorney who is not a resident of the United States may represent parties located in the country in which the foreign attorney resides and practices, if

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(1) he or she proves to the satisfaction of the Office of Enrollment and Discipline (OED) that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices; and (2) the patent or trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice before the USPTO. A foreign attorney who meets the requirements of 37 C.F.R. §10.14(c) can only represent parties located in the country in which the foreign attorney resides and practices. The foreign attorney cannot represent parties located in the United States or other foreign countries.

Currently, Canadian attorneys are the only foreign attorneys recognized as meeting the qualification criteria of 37 C.F.R. §10.14(c). OED maintains a list of attorneys who are registered or in good standing with the Canadian Intellectual Property Office, which is available to USPTO employees through the Office's internal computer network. When a Canadian attorney represents a party in a proceeding in the USPTO, the examining attorney should verify that the attorney is in fact recognized by the Director of OED.

An attorney who resides and practices in a foreign country other than Canada and who is not a member in good standing of the bar of a United States court or the highest court of any State may not practice before the USPTO. Any such attorney who wishes to represent an applicant in a trademark matter must file a written request to do so with OED. This request should include proof that the attorney is in good standing with the foreign patent or trademark office, and that the foreign patent or trademark office provides substantially reciprocal rights to United States attorneys.

### *Non-Attorneys*

Non-attorneys are not permitted to practice except under the limited circumstances specified in 37 C.F.R. §10.14(b).

When an applicant is represented by counsel, the Office encourages the practice of direct communication with the appointed attorney(s). Although paralegals and legal assistants may convey information between the examining attorney and the appointed attorney(s), they are not authorized to conduct business before the Office. 37 C.F.R. §10.14(b). For example, a non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) (*see* TMEP §804.04) may not sign responses to Office actions, or authorize examiner's amendments and priority actions, unless he or she has legal authority to bind the applicant (*e.g.*, a corporate officer or partner of a partnership). *See* 37 C.F.R. §§10.14(e) and 10.18(a). *See also* TMEP §§712.01 *et seq.* for more information about persons who can sign responses to Office actions, TMEP §§707 *et seq.* regarding examiner's amendments, and TMEP §§708 *et seq.* regarding priority actions. Paralegals and legal assistants are not authorized to negotiate, argue a position, officially accept or reject Office requirements, or otherwise prosecute a matter before the Office.

Use of the term "agent" in connection with a representative in a trademark case is only appropriate under the limited circumstances specified in 37 C.F.R. §10.14(b).

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### 602.01 Powers of Attorney [R-1]

37 C.F.R. §2.17(c). *To be recognized as a representative, an attorney as defined in §10.1(c) of this chapter may file a power of attorney, appear in person, or sign a paper on behalf of an applicant or registrant that is filed with the Office in a trademark case.*

37 C.F.R. §2.17(d) *A party may file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations of that party. A party relying on such a power of attorney must:*

(1) *Include a copy of the previously filed power of attorney; or*

(2) *Refer to the power of attorney, specifying the filing date of the previously filed power of attorney; the application serial number (if known), registration number, or inter partes proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date.*

Generally, it is not necessary for an attorney at law to file a power of attorney or any other special authorization in a trademark case. An attorney at law who appears in person or signs a paper on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. 37 C.F.R. §§2.17(a) and (c).

If an attorney files a proper power of attorney from the party he or she represents, the Office will accept the power. To be acceptable as a power of attorney, the power must identify an individual attorney(s) by name, not merely specify the name of a law firm. If a power specifies only the name of a law firm, the Office will treat it as a correspondence address rather than an authorization to conduct business. *See* TMEP §§603 *et seq.* regarding the correspondence address.

An attorney cannot sign an original power of attorney on behalf of his or her client. An original power of attorney, other than one associating an additional attorney with an already authorized attorney (*see* TMEP §602.01(b)), must be signed by the individual applicant, or by someone with legal authority to bind a juristic applicant (*e.g.*, a corporate officer or partner of a partnership).

If a power of attorney is signed by an improper person (*e.g.*, the applicant's attorney), the examining attorney generally does not have to require a properly signed power, because the filing of a power of attorney is not mandatory in a trademark case. *See* 37 C.F.R. §2.17(c). (However, if an applicant is already represented by an attorney, and a new attorney takes over, the applicant must file either a new power of attorney or a written request to change the correspondence address, signed by the applicant, before the Office will correspond with the new attorney. *See* TMEP §§602.04 and 603.02(a).)

If no power of attorney is filed, the Office will presume that an attorney is the attorney of record in an application if: (1) the original application is accompanied by a cover letter or transmittal letter that is signed by an attorney and identifies the name and address of that

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attorney; (2) the application is filed electronically using Trademark Electronic Application System (TEAS) (*see* TMEP §301), and the attorney information section is completed; or (3) the application is filed by a *pro se* applicant (*i.e.*, an applicant who does not have an attorney), and correspondence is subsequently filed that is signed by an attorney and identifies the name and address of that attorney, either on the correspondence itself or on the transmittal letter that accompanies the correspondence. The Office presumes that papers filed by practitioners are authorized to be filed.

The Office considers a power of attorney to end with respect to a particular application when the mark is registered, when ownership changes, or when the application is abandoned. *See* TMEP §602.01(c) regarding the processing of powers of attorney filed after registration.

If an attorney is suspended or excluded by the Director of the USPTO, a power of attorney should be regarded as void as of the date of suspension or exclusion, a power of attorney should be regarded as void as of the date of suspension or exclusion, and no oral or written communication should be made with the attorney as of that date. Any correspondence filed by a suspended or excluded attorney should be treated as correspondence filed by an unauthorized person, pursuant to TMEP §602.03.

*See also* TMEP §602.04 regarding revocation of a power of attorney, and TMEP §603.02 regarding changes in the correspondence address.

### **602.01(a) Power of Attorney Relating to More Than One Application or Registration**

An applicant or registrant may file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations. Someone relying on such a power of attorney must: (1) include a copy of the previously filed power of attorney; or (2) refer to the previously filed power of attorney, specifying: the filing date of the power; the application serial number (if known), registration number, or *inter partes* proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date. 37 C.F.R. §2.17(d). If the applicant or registrant meets these requirements, the examining attorney should accept the power of attorney.

### **602.01(b) Associate Powers of Attorney**

Once the applicant has designated an attorney, the attorney may sign an associate power of attorney appointing another attorney as an additional person authorized to prosecute the application. If the applicant revokes the original power of attorney, this revocation also discharges any associate power signed by the attorney whose power has been revoked. *See* TMEP §602.04 regarding revocation of a power of attorney.

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### **602.01(c) Powers of Attorney Filed After Registration**

The Office considers a power of attorney to end with registration.

When a registrant files a new power of attorney after registration, the Office does not update the TRAM (Trademark Reporting and Monitoring) System unless the registrant takes an action with respect to the registration, such as filing an affidavit or declaration of continued use under 15 U.S.C. §1058 (§8 affidavit), renewal application under 15 U.S.C. §1059, or request to amend the registration under 15 U.S.C. §1057(e). When the registrant files a new power of attorney without taking an action, the Office simply places the power of attorney in the registration file. Similarly, where a registrant revokes a power of attorney filed before registration or an attorney appointed before registration files a request to withdraw as attorney of record, the Office places these documents in the file but does not change the attorney of record in TRAM unless the registrant takes an action with respect to the registration.

When a registrant takes an action with respect to a registration (such as filing a §8 affidavit, renewal application, or request to amend a registration), the Office will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application, or amendment.

### **602.02 Standards of Conduct**

*37 C.F.R. §10.15. Refusal to recognize a practitioner. Any practitioner authorized to appear before the Office may be suspended or excluded in accordance with the provisions of this part. Any practitioner who is suspended or excluded under this subpart or removed under section 10.11(b) shall not be entitled to practice before the Office.*

*37 C.F.R. §10.20. Canons and Disciplinary Rules.*

*(a) Canons are set out in §§10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110. Canons are statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession.*

*(b) Disciplinary Rules are set out in §§10.22 - 10.24, 10.31 - 10.40, 10.47 - 10.57, 10.62 - 10.68, 10.77, 10.78, 10.84, 10.85, 10.87 - 10.89, 10.92, 10.93, 10.101 - 10.103, 10.111, and 10.112. Disciplinary Rules are mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.*

Part 10 of Title 37 of the Code of Federal Regulations pertains to representation of others before the USPTO. Part 10 establishes an Office of Enrollment and Discipline; identifies and defines individuals entitled to practice before the Office; establishes a mandatory Code of Professional Responsibility; and defines a procedure for investigations and disciplinary proceedings.

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### **602.02(a) Signature and Certificate for Correspondence filed in the United States Patent and Trademark Office [R-2]**

*37 C.F.R. §10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.*

*(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.*

*(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

*(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and*

*(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-*

*(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;*

*(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*

*(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

*(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

*(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of-*

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- (1) *Holding certain facts to have been established;*
  - (2) *Returning papers;*
  - (3) *Precluding a party from filing a paper, or presenting or contesting an issue;*
  - (4) *Imposing a monetary sanction;*
  - (5) *Requiring a terminal disclaimer for the period of the delay; or*
  - (6) *Terminating the proceedings in the Patent and Trademark Office.*
- (d) *Any practitioner violating the provisions of this section may also be subject to disciplinary action. See §10.23(c)(15).*

### **602.03 Papers Filed by Unauthorized Persons**

Under 37 C.F.R. §10.18(a), every paper filed by a practitioner qualified under 37 C.F.R. §10.14 to practice before the Office in trademark cases, except for papers required to be signed by the applicant or party, must be personally signed by the practitioner. (See TMEP §§602.01 and 604 for examples of papers that must be signed by the applicant or registrant.) The signature constitutes a certificate that the paper's filing is authorized. 37 C.F.R. §10.18(b)(1). Therefore, the Office presumes that papers signed by practitioners are authorized to be filed and will enter such papers in the file.

An individual who is not qualified under 37 C.F.R. §10.14(a), (b), or (c) to practice before the Office in trademark cases is not permitted to represent a party in the prosecution of a trademark application, maintenance of a registration, or in a proceeding before the Office. 5 U.S.C. §500(d); 37 C.F.R. §10.14(e). If the examining attorney suspects that an individual who does not meet the requirements of 37 C.F.R. §10.14 is representing an applicant, the examining attorney should bring the matter to the attention of the Administrator for Trademark Policy and Procedure in the Office of the Commissioner for Trademarks, who will coordinate appropriate action with the Office of Enrollment and Discipline.

### **602.04 Revocation or Withdrawal of Authorization [R-2]**

*37 C.F.R. §2.19(a). Revocation of power of attorney or of other authorization to represent; withdrawal. Authority to represent an applicant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon notification to the Director; and when it is so revoked, the Office will communicate directly with the applicant or party to the proceeding or with such other qualified person as may be authorized. The Patent and Trademark Office will notify the person affected of the revocation of his or her authorization.*

An applicant may revoke a power of attorney by a written revocation. The Office will acknowledge the revocation and will no longer recognize the attorney in that case unless he or she is again specifically appointed.

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When an applicant is represented by an attorney, a change in representation can be made only by a written request signed by the applicant. If the applicant files a new power of attorney, the address contained in the new power of attorney becomes the address of record for correspondence purposes. If the applicant files a revocation of the previous power of attorney without a new power of attorney, correspondence will be sent either to (1) the applicant, or (2) the attorney signing the cover letter or action accompanying the revocation.

The new attorney cannot sign a new power of attorney or revocation of the previous power of attorney on behalf of the applicant. The revocation must be signed by the individual applicant, or by someone with legal authority to bind a juristic applicant (*e.g.*, a corporate officer or partner of a partnership).

Where a registrant revokes a power of attorney filed before registration, the Office places the revocation in the registration file but does not change the attorney of record in TRAM unless the registrant takes an action with respect to the registration (*e.g.*, filing a §8 affidavit, renewal application, or request to amend a registration). *See* TMEP §§602.01(c) and 1612.

### **602.04(a) Permissive Withdrawal of Attorney of Record [R-2]**

*37 C.F.R. §2.19(b). An individual authorized to represent an applicant or party in a trademark case may withdraw upon application to and approval by the Director.*

An attorney may withdraw from representing an applicant or registrant, but may not withdraw in a way that would prejudice the applicant or registrant. *In re Legendary, Inc.*, 26 USPQ2d 1478 (Comm'r Pats. 1992) (attorney's request to withdraw denied where the request was filed on the last day of the period for response to an Office action and attorney stated neither that the applicant was given due notice of the attorney's withdrawal from employment nor that the attorney had delivered all papers and property in his file concerning the prosecution of the application to the applicant). *See* 37 C.F.R. §10.40 regarding mandatory and permissive withdrawal from employment by an attorney.

Before registration, a request for permission to withdraw as attorney will be handled by the appropriate managing attorney, or, if a notice of allowance has issued and the application is awaiting the filing of a statement of use, by the Supervisor of the ITU/Divisional Unit. After registration, a request for permission to withdraw as attorney will be handled by the Supervisor of the Post Registration Section of the Office.

A request to withdraw must include the following:

- (1) A statement of the reason(s) for the request to withdraw (*see* 37 C.F.R. §10.40);
- (2) A statement that the attorney has given due notice to the applicant or registrant that the attorney is withdrawing from employment and will be filing the necessary papers with the Office; and that the applicant or registrant was given notice of the withdrawal at least two months before the expiration of the response period;

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- (3) A statement that the attorney has delivered to the applicant or registrant all papers and property in the attorney's file concerning the prosecution of the application or registration; and
- (4) A statement that the attorney notified the applicant or registrant of any responses that may be due and the deadline for response.

A request to withdraw should be filed soon after the representative notifies the applicant or registrant of his or her intent to withdraw. If an applicant or registrant was notified of the attorney's withdrawal from employment at least two months before the expiration of the response period, and the request to withdraw meets all the requirements listed above, the request will be granted. *In re Slack*, 54 USPQ2d 1504 (Comm'r Pats. 2000).

In addition to the above, the request for permission to withdraw as attorney of record should be titled "Request for Permission to Withdraw as Attorney of Record" and contain the following:

- (1) The application serial number or registration number;
- (2) The law office to which the application is assigned, in a pending application;
- (3) The name of the examining attorney or Post Registration examiner assigned; and
- (4) The present mailing address of the attorney who is withdrawing and the present mailing address of the applicant or registrant.

The managing attorney or supervisor will approve or deny the request, notify the applicant or registrant and the attorney of the approval or denial of the request, and place a record of this notification (*i.e.*, a copy of the written communication or telephone call record) in the file. If the request is approved, the managing attorney or supervisor should ensure that the correspondence address is changed in the Office's automated records. It is the responsibility of the managing attorneys or supervisors to establish procedures that permit withdrawal requests to be given priority and acted on promptly.

If the attorney who seeks to withdraw is also the domestic representative, the managing attorney or supervisor should inquire as to whether the attorney intends to withdraw as domestic representative. If the attorney withdraws as domestic representative, the managing attorney or supervisor should ensure that the domestic representative field in the TRAM (Trademark Reporting and Monitoring) System is updated accordingly. *See* TMEP §604 regarding designations of domestic representative.

Where an attorney appointed before registration files a request to withdraw after registration, the Office places the request in the registration file but does not change the attorney of record in TRAM unless the registrant takes an action with respect to the registration (*e.g.*, filing a §8 affidavit, renewal application, or request to amend a registration). *See* TMEP §§602.01(c) and 1611.

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### 603 Correspondence, With Whom Held [R-2]

*37 C.F.R. §2.18 Correspondence, with whom held.*

*If papers are transmitted by an attorney at law, or a written power of attorney is filed, the United States Patent and Trademark Office will send correspondence to the attorney at law transmitting the papers, or to the attorney at law designated in the power of attorney. If an application or proceeding is not being prosecuted by an attorney at law, and the applicant, registrant or party to a proceeding before the Office has appointed a domestic representative, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another address to which correspondence is to be sent. If the application or proceeding is not being prosecuted by an attorney and the applicant, registrant or party has not designated a domestic representative, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another address to which correspondence is to be sent.*

*Correspondence will continue to be sent to such address until the applicant, registrant or party, or the attorney or other authorized representative of the applicant, registrant or party, indicates in writing that correspondence is to be sent to another address. The Office will not undertake double correspondence, and if more than one attorney at law or other authorized representative appears or signs a paper, the Office's reply will be sent to the address already established in the record until another correspondence address is specified by the applicant, registrant or party or by the attorney or other authorized representative of the applicant, registrant or party.*

#### 603.01 Establishing the Correspondence Address

When a trademark application is filed, the Office enters into its automated records an address (consisting of a name, street address or post office box, city, state and postal code) where correspondence from the Office will be sent. This often differs from the applicant's address. Correspondence will be sent to any address within the United States that the applicant selects. The Office will send correspondence to Canada if the applicant selects a Canadian attorney or agent who is duly qualified under 37 C.F.R. §10.14(c) to practice before the Office (*see* TMEP §602). *See* TMEP §603.05 regarding correspondence with applicants who are not domiciled in the United States.

When the application includes a power of attorney that designates an attorney(s) and an address, or a form that has the appearance of a power of attorney that designates the name and address of an attorney, the Office will correspond with the designated attorney. In addition, the Office will presume that the applicant wishes correspondence to be sent to an attorney's address rather than directly to the applicant when:

- (1) The name and address of an attorney appears in the original application papers;
- (2) The original application is accompanied by a transmittal letter on letterhead that identifies an attorney;

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- (3) The application is filed electronically using TEAS (*see* TMEP §301), and the attorney information section is completed; or
- (4) The original application is written on paper that identifies the name and address of an attorney.

The above procedures are also used to establish the correspondence address when a registrant files a §8 affidavit, renewal application, or request for amendment or correction of a registration under 15 U.S.C. §1057. The Office will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application, or amendment.

*See* TMEP §603.02(a) for information about changing the correspondence address in a pending application, and TMEP §603.02(c) for information about changing the correspondence address after registration.

### **603.02 Changing the Correspondence Address [R-1]**

Notices of change of correspondence address should be filed electronically through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). When a notice is filed electronically, the Office receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. The TEAS form can be used to change the correspondence address on any application or registration that is currently active. The data from the form is inputted directly into the automated records of the Office. *See* TMEP §603.02(b) for information about how to change the correspondence address in multiple applications or registrations.

#### **603.02(a) Changing the Correspondence Address Before Registration [R-1]**

Once the correspondence address is established for a particular application, it is not changed unless there is a written request by the applicant or the attorney of record to change the address. The mere transmittal of a response to an Office action bearing a new address for an applicant or an applicant's attorney does not effect a change in a correspondence address.

If an applicant is represented by an attorney ("A"), and another attorney ("B") later responds on behalf of the applicant and requests that correspondence be sent to B, B will be required to submit written authorization from the applicant for the requested change in correspondence address. Correspondence will continue to be sent to A until B submits the necessary authorization from the applicant. Attorney B cannot sign a request to change the correspondence address on behalf of the applicant. *See* TMEP §603.04 regarding processing of correspondence that is signed by someone other than the applicant or the applicant's designated attorney.

The Office will construe the following as a written request to change the correspondence address:

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- (1) A new power of attorney, signed by someone authorized to bind the applicant (*see* TMEP §602.01), is filed, even if there is no revocation of a previous power of attorney (however, the filing of an “associate power of attorney” or similar paper does not change the correspondence address); or
- (2) The application is filed by a *pro se* applicant, and correspondence is subsequently filed that identifies the name and address of an attorney, either on the correspondence itself or on the transmittal letter that accompanies the correspondence, even if no power of attorney is filed.

In these two situations, the Office will change the correspondence address to the address of the new attorney. In all other situations, a written request to change the correspondence address, signed by the applicant, is required.

To expedite processing, the Office recommends that the notice of change of address be filed electronically through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). When the notice is filed electronically, the Office receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. The TEAS form can be used to change the correspondence address on any application or registration that is currently active. The data from the form is inputted directly into the automated records of the Office. *See* TMEP §603.02(b) for information about how to change the correspondence address in multiple applications or registrations.

When a request to change the correspondence address is filed on paper, the Office manually enters the new correspondence address into its automated records and places the request in the application file, but does not send a confirmation or other acknowledgment of the request to change the correspondence address. The applicant may check the Trademark Applications and Registrations Retrieval (TARR) database at <http://tarr.uspto.gov> to determine whether the change of address has been entered into the automated records of the Office.

A change of correspondence address cannot be entered by examiner’s amendment.

When ownership of an application changes and the proper document is recorded in the Assignment Services Division, the Office will update its automated records to reflect the address of the assignee or the assignee’s attorney, even if the assignee does not specifically request a change of address.

The Office will not process a request to change the correspondence address in an abandoned application. When an applicant files a request to change the correspondence address in an abandoned application, the Office simply places the request in the application file.

The Office will not undertake double correspondence with the applicant and the applicant’s attorney or with more than one attorney or representative.

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### **603.02(b) Changing the Correspondence Address in Multiple Applications or Registrations [R-1]**

A single TEAS form for recording a change of address, found at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html), can be used to notice a change of address for more than one application or registration. The TEAS form can be used to change the correspondence address only on applications or registrations that are currently active.

### **603.02(c) Changing the Correspondence Address After Registration [R-1]**

To expedite processing, the Office recommends that the notice of change of address be filed electronically through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). When the notice is filed electronically, the Office receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail that includes the date of receipt and a summary of the submission. The TEAS form can be used to change the correspondence address on any registration that is currently active. The data from the form is inputted directly into the Office's automated system.

When a registrant files a request on paper to change the correspondence address after a registration issues, the Office does not update the TRAM System unless the registrant takes an action with respect to the registration, such as filing a §8 affidavit, renewal application, or request to amend the registration. When the registrant files a paper requesting a change of correspondence address without taking an action, the Office simply places the request in the registration file. If the registrant wants the new address entered into the TRAM system, the registrant must file the notice of change of address electronically through TEAS.

When a registrant takes an action with respect to a registration, the Office will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application, or amendment. If the registrant does not have an attorney, the Office updates TRAM to indicate the registrant's address as shown in the affidavit, renewal application or amendment.

### **603.03 Applicant Has Duty to Maintain Current and Accurate Correspondence Address**

It is the applicant's responsibility to maintain a current and accurate correspondence address in its application file. If the correspondence address changes, the Office must be promptly notified in writing. 37 C.F.R. §2.18.

### **603.04 Processing Correspondence Signed by Someone Other Than the Applicant or the Applicant's Designated Attorney**

During the prosecution of a trademark application, every action that is not signed by the applicant must be signed by a practitioner qualified under 37 C.F.R. §10.14 to practice before the Office in trademark cases. 37 C.F.R. §10.18(a) and TMEP §§602.03 and 712 *et seq.*

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Any action that is so signed will be accepted regardless of whether the practitioner who has signed is the same person who signed previously submitted papers, and regardless of whether the practitioner has filed a power of attorney. 37 C.F.R. §2.17(c). However, if the signer is different, the Office will continue to send correspondence to the correspondence address already established unless and until there is a written request to change that address.

*Example:* If an application as originally filed is accompanied by a transmittal letter bearing the name and address of an attorney, the attorney's name and address will be entered into the records of the Office as the correspondence address (*see* TMEP §603.01). If a response to an Office action signed by a different attorney is subsequently filed, the Office will accept and act on the response, but will continue to send correspondence to the mailing address originally established until there is a written request to change that address.

*See* TMEP §§603.02 *et seq.* regarding requests to change the correspondence address.

The examining attorney should ensure that the person who signs each paper, if not the applicant, is either an attorney at law (which normally can be presumed from the attorney's own statement or identification) or other authorized party. *See* TMEP §602 regarding persons who may practice before the Office in trademark matters, TMEP §602.03 regarding papers filed by unauthorized persons, and TMEP §§712.01 *et seq.* regarding the proper person to sign a response to an Office action.

### **603.05 Correspondence with Parties Not Domiciled in the United States [R-2]**

If an applicant, registrant or party to a proceeding before the Office has authorized a practitioner qualified to practice before the Office in trademark cases under 37 C.F.R. §10.14, the Office will send correspondence to that attorney only if: (1) the practitioner has a United States correspondence address, or (2) the practitioner resides in a foreign country but is qualified under 37 C.F.R. §10.14(c). Currently, Canadian attorneys are the only foreign attorneys recognized as meeting the qualification criteria in 37 C.F.R. §10.14(c) (*see* TMEP §602).

If an applicant, registrant or party is not represented by an attorney qualified under 37 C.F.R. §10.14, and the applicant/registrant/party has appointed a domestic representative, the Office will send correspondence to the domestic representative, unless the applicant/registrant/party designates in writing another correspondence address. However, the domestic representative is not authorized to prosecute an application or represent a party in a proceeding before the Office, unless the domestic representative is a practitioner qualified by 37 C.F.R. §10.14 to practice before the Office in trademark cases. 37 C.F.R. §2.24. *See* TMEP §604 regarding domestic representatives.

If an application or proceeding is not being prosecuted by an attorney and the applicant/registrant/party has not designated a domestic representative pursuant to §2.24, the

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Office will send correspondence directly to the applicant/registrant/party, unless the applicant/registrant/party designates in writing another correspondence address.

If an applicant, registrant or party to a proceeding before the Office who is not domiciled in the United States is not represented by a practitioner qualified under 37 C.F.R. §10.14 to practice before the Office in trademark cases, and the applicant/registrant/party does not designate a domestic representative, the Office will send correspondence directly to the applicant/registrant/party's foreign address.

### **604 Designation of Domestic Representative by Parties Not Domiciled in the United States [R-2]**

An applicant, registrant, or party to a proceeding before the Office who is not domiciled in the United States may file a document designating the name and address of a domestic representative on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §§1051(e), 1058(f), 1059(c) and 1060. The Office encourages parties who do not reside in the United States to designate domestic representatives, but it is not mandatory. If the applicant, registrant, or party does not designate a domestic representative, the Office will not require a designation.

The designation is not the same as a power of attorney. The designation serves a different purpose, namely, to bring foreign applicants, registrants and parties under the jurisdiction of the United States legal system. The designation of a domestic representative does not authorize the person designated to prosecute the application or to represent a party in a proceeding before the Office. 37 C.F.R. §2.24. Similarly, a power of attorney does not serve as a designation of a domestic representative unless the power of attorney specifically states that the attorney is also the domestic representative on whom may be served notices or process in proceedings affecting the mark.

If a party designates a domestic representative, the designation should include the name and address of the person designated, and a clear statement that the party intends to designate this person as a domestic representative upon whom notices or process affecting the mark may be served. The designation must be in writing. A person who is properly authorized to sign a designation of domestic representative is:

- (1) A person with legal authority to bind the applicant or party; or
- (2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant or party; or
- (3) An attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the applicant or party.

*See* TMEP §804.04.

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The person designated as a domestic representative may be a natural person or a juristic person as defined in 15 U.S.C. §1127.

If an applicant, registrant or party to a proceeding before the Office does not file a document designating a domestic representative, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. 15 U.S.C. §§1051(e), 1058(f), 1059(c) and 1060.

*See* TMEP §603.05 regarding correspondence with parties who are not domiciled in the United States.